

## REMARKS

### I. Introduction

Applicant has carefully studied the outstanding Office Action. The present response is intended to place the application in condition for allowance and is believed to overcome all outstanding rejections. Withdrawal of the current rejections and allowance of the pending claims are respectfully requested.

By this response, applicants have cancelled claims 37, 58, 75 and 90, and amended claims 8-14, 19, 26-36, 39, 48-51, 66-67, 73-74, and 83. No new matter has been added. Claims 1-36, 38-57, 59-74 and 76-89 remain pending in this application.

### II. Claim Rejections under 35 U.S.C. § 112, second paragraph

The Office Action rejected claims 8-14, 19-36, 26-32, 39-41, 48-57, 66, and 74 under 35 U.S.C. § 112, second paragraph. Applicants submit that the amended claims overcome these rejections for at least the following reasons.

#### a. "Audit Record"

The Office Action rejected claims 8-14, 26-32, 39-41, 49-51, 66, and 74 for reciting an "audit record". (See, Office Action, p. 2, section 2) In rejecting these claims, the Office Action states that "[i]t is unclear what distinguishes an 'audit record' from any other form of record." (*Id.*)

Although applicants do not concur in this rejection, applicants have amended the claims to recite that each audit record "stores information identifying a distribution route of [an] electronic document". Support for these amendments can be found in the original specification at p. 2, lines 12-14 and p. 5, lines 13-14.

In view of these amendments and the explanations of "audit record" in the original specification, the meaning of "audit record" as recited in the claims is clear and distinct from other forms of records. Accordingly, applicants submit that the amended claims overcome the rejections under 35 U.S.C. § 112 based on the recitation of "audit record".

#### b. "Auto-Marker"

The Office Action rejected claims 19-36 and 48-57 for reciting an "auto-marker". (See, Office Action, p. 2, section 3) In rejecting these claims, the Office Action states that "it is unclear what distinguishes an 'auto-marker' from any other marker". (*Id.*)

Although applicants do not concur in this rejection, applications have amended the claims by replacing "auto-marker" with "auto-marking module". As described in the original specification, and auto-marking module embeds a unique identifier within an electronic document. (See, original specification, p. 3, lines 3-9 and p. 8, lines 8-14)

In view of these amendments and the explanations of "auto-marking module" in the original specification, applicants submit that the amended claims overcome the rejections under 35 U.S.C. § 112 based on the recitation of "auto-marker".

### III. Claim Rejections under 35 U.S.C. § 101

The Office Action rejected several claims under 35 U.S.C. § 101. Applicants submit that the amended claims overcome these rejections for at least the following reasons.

#### a. Claims 19-36, 48-57, 67-74, and 83-89

The Office Action rejected claims 19-36, 48-57, 67-74, and 83-89 under 35 U.S.C. § 101, stating that "the claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 U.S.C. § 101". (See, Office Action, p. 3, lines 1-4)

Although applicants do not concur in this rejection, applicants have amended the claims to recite "a system comprising one or more tangible computer-readable media storing instructions." Support for these amendments is found in the original specification at p. 7, lines 9-23, and p. 3, lines 27-32.

In view of these amendments, the rejected claims are clearly directed to tangible articles, thus satisfying the requirements of 35 U.S.C. § 101. Accordingly, applicants respectfully request withdrawal of the claim rejections under 35 U.S.C. § 101.

#### b. Claims 37, 58, 75, and 90

The Office Action rejected claims 37, 58, 75, and 90 under 35 U.S.C. § 101. Although applicants do not concur in these rejections, the rejections are moot in view of the cancellation of each of the claims.

### IV. Claim Rejections under 35 U.S.C. § 102

The Office Action rejected several claims under 35 U.S.C. § 102. Applicants respectfully traverse these rejections for reasons presented below.

a. Tsuji

The Office Action rejected claims 1, 8, 9, 11 – 16, 19, 26, 27, 29 – 34, 37 – 39, 41, 42, 48, 49, 51, 52 and 58 under 35 U.S.C. §102(b) as being allegedly anticipated by U.S. Patent No. 5,764,898 to Tsuji et al. ("Tsuji").

Tsuji describes the tracking of workstation processing tasks to be performed on electronic mail. In Tsuji, a sender of electronic mail indicates processing to be performed by one or more recipients of the electronic mail. (See, Tsuji, col. 2, lines 46 – 49; col. 4, lines 12 – 24; col. 4, line 64 – col. 5, line 4; element 34 of FIG. 1; element 41 of FIG. 3) This indication of processing is referred to as "control information". (*Id.*) Processing performed by the recipients of the electronic mail is stored within a processing log. (See, Tsuji, col. 2, lines 49 – 53; col. 4, lines 31 – 35; element 22 of FIG. 1). The sender is thereby able to track the processing of the electronic mail (See, Tsuji, col. 3, lines 1 – 7; col. 4, lines 43 – 47; elements 36 and 37 of FIG. 1; element 45 of FIG. 4).

Tsuji fails to disclose several features recited in independent claims 1, 19, 38, and 48, including at least the following: (1) embedding a unique identifier in an electronic document; and (2) monitoring emails or network packets for documents having an embedded identifier.

Regarding (1), the Office Action apparently equates the control information of Tsuji with the unique identifier recited in the claims. (See, e.g., Office Action, p. 4, section 6; the "tracking object" mentioned in section 6 of the Office Action is never discussed in Tsuji) However, the control information in Tsuji is not embedded in an electronic document. Rather, the control information in Tsuji exists independent of any electronic document and is added "to the mail text" of an email before the email is sent. (See, Tsuji, col. 4, lines 14-18) Because the control information of Tsuji is not embedded in an electronic document, independent claims 1, 19, 38, and 48 are patentable over Tsuji.

It should be further noted that the language of independent claims 1, 19, 38, and 48 distinguishes between an email message and an electronic document embedded in or attached to an email message. Accordingly, even if the control information of Tsuji were interpreted to be embedded within an email message, it should not be interpreted to be embedded within an electronic document attached to or embedded in an email message.

Regarding (2), the Office Action apparently concludes that the task tracking unit 37 of Tsuji performs a function of monitoring email messages and network packets for documents including embedded identifiers. (See, e.g., Office Action, p. 4-5, section 6) However, the task tracking unit 37 does not monitor email messages or network packets for documents including embedded identifiers. Rather, the task tracking unit 37 resides on a receiving work station and responds to specific inquiries or requests from a sending work station about email messages that the receiving machine has received from the sending work station. (See, e.g., Tsuji, col. 4, lines 48-55) In response to these inquiries or requests, the task tracking unit 37 inspects and/or updates information stored in a received mail memory unit 24. (Id.) However, the task tracking unit 37 never monitors any email messages or network packets for documents including embedded identifiers.

Because Tsuji fails to disclose the features (1) and (2) discussed above, independent claims 1, 19, 38, and 48 are patentable over Tsuji. Additionally, dependent claims 2-18, 19-36, 39-47, and 49-57 are patentable over Tsuji based on their dependence from patentable independent claims.

b. Barchi

The Office Action rejected claims 59-79, 83-86 and 90 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,507,866 to Barchi ("Barchi").

Barchi describes the use of pattern detection for identifying and filtering unwanted e-mails. Barchi accumulates statistical frequencies regarding header fields of incoming e-mails, and detects fields for which the frequencies exceed an absolute or relative threshold (See, e.g., Barchi, col. 5, lines 44- 54 and 59-62; col. 6, lines 30-36; FIGS. 5-8). Unwanted e-mails are pre-filtered using SMTPvalidate, which checks whether received e-mail messages match information maintained in a deny list (See, e.g., Barchi, col. 6, lines 5-11 and lines 50-53).

Independent claims 59, 67 each recites scanning intercepted email messages to detect a specified electronic document. Independent claims 76, and 83 each recites scanning intercepted network packets to detect a specified electronic document. Barchi does not disclose scanning intercepted email messages or network packets for specified electronic documents.

The Office Action concludes that Barchi discloses scanning intercepted email messages or network packets for specified electronic documents at col. 6, lines 4-26. However, the cited portion of Barchi contains no disclosure related to scanning

electronic documents or detection of specified electronic documents. Additionally, the cited portion of Barchi contains no disclosure related to analyzing network packets. The cited portion of Barchi merely discusses extracting particular information from email messages and analyzing the extracted information.

As discussed above, the claims distinguish between email messages and network packets and electronic documents. Accordingly, because Barchi merely discusses analyzing email messages, but does not discuss electronic documents, Barchi cannot be reasonably interpreted to teach scanning intercepted email messages or network packets to detect a specified electronic document as recited in the claims.

Because Barchi fails to disclose these features, independent claims 59, 67, 76, and 83 are patentable over Barchi. Additionally, dependent claims 60-66, 68-74, 77-82, and 84-86 are patentable based on their dependence from patentable independent claims.

V. Claim Rejections under 35 U.S.C. § 103

The Office Action rejected claims 2-7, 10, 17-18, 20-25, 35-36, 40, 44-47, 50, 53-57, 80-82 and 87-89 under 35 U.S.C. § 103(a). As discussed above, these claims are patentable over the art of record based on their dependence from patentable independent claims.

VI. Conclusion

No other issues remaining, applicants respectfully request withdrawal of the outstanding rejections and allowance of the pending claims.

A petition for a three (3) month extension of time is included with this submission. Please charge any additional fees or credit any overpayments to Deposit Account No. 50-2283, under Order No. 60644.8011.US1 from which the undersigned is authorized to draw.

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Respectfully submitted,

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